UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/520,952	01/10/2006	Matthias Hauser	J&J2126USPCT	4882

27777 7590 11/26/2008

PHILIP S. JOHNSON
JOHNSON & JOHNSON
ONE JOHNSON & JOHNSON PLAZA
NEW BRUNSWICK, NJ 08933-7003

EXAMINER	
LOVE, TREVOR M	

ART UNIT	PAPER NUMBER
1611	

MAIL DATE	DELIVERY MODE
11/26/2008	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/520,952	HAUSER ET AL.	
	Examiner	Art Unit	
	TREVOR M. LOVE	1611	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *04/18/2008*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-33, 35* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-33, 35* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date *06/06/2007, 07/10/2007, 04/18/2008*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Acknowledgement is made to applicant's Information Disclosure Statements filed 06/06/2007, 07/10/2007, and 04/18/2008. Also, applicant's preliminary amendment filed upon initial filing, 01/11/2005, is acknowledged.

Claims 1-33 and 35 are pending. Claim 34 is cancelled. Claims 4, 8-10, 12, 13, 16, 17, 19-21, 23-29, 31, and 33 are currently amended per the preliminary amendment file 01/11/2005. Claim 35 is new per the preliminary amendment filed 01/11/2005.

Claim Objections

Claim 5 is objected to because of the following informalities: the claim reads "...mono-, d-, or triglycerides...". It is the position of the Examiner that this is an obvious error, and for the purposes of compact prosecution, the Examiner will interpret the claim as reading "...mono-, di-, or triglycerides...". Appropriate correction is required.

Claim 14 is objected to because of the following informalities: the line through of the word "acids" renders the sentence incomplete. It is the position of the Examiner that this is an obvious error, and for the purposes of compact prosecution, the Examiner will interpret the claim as though the first time the word "acids" is lined through, it is rather present. Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 8, 20, and 27 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

A broad range or limitation together with a narrow range or limitation that falls within the broad range or limitation (in the same claim) is considered indefinite, since the resulting claim does not clearly set forth the metes and bounds of the patent protection desired. See MPEP § 2173.05(c). Note the explanation given by the Board of Patent Appeals and Interferences in *Ex parte Wu*, 10 USPQ2d 2031, 2033 (Bd. Pat. App. & Inter. 1989), as to where broad language is followed by "such as" and then narrow language. The Board stated that this can render a claim indefinite by raising a question or doubt as to whether the feature introduced by such language is (a) merely exemplary of the remainder of the claim, and therefore not required, or (b) a required feature of the claims. Note also, for example, the decisions of *Ex parte Steigewald*, 131 USPQ 74 (Bd. App. 1961); *Ex parte Hall*, 83 USPQ 38 (Bd. App. 1948); and *Ex parte Hasche*, 86 USPQ 481 (Bd. App. 1949). In the present instance, **claim 8** recites the broad recitation of “at least 50 %”, and the claim also recites “preferably at least 70 %” and “more preferably at least 90 %”, which are the narrower statements of the range/limitation.

Regarding **claims 20 and 27**, the use of parentheses renders the claim indefinite because it is unclear whether the limitation(s) within the parentheses is/are part of the claimed invention. See MPEP § 2173.05(d).

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-33, and 35 are rejected under 35 U.S.C. 102(b) as being anticipated by McAtee et al (U.S. Patent 6,153,208).

McAtee discloses a substantially dry, disposable, personal cleansing article useful for both cleansing the skin or hair (see abstract). The same as **instant claim 1**, said cleansing article comprises a substrate, a surfactant phase, and a lipid phase (see examples 1-5). Said lipid phase comprises hardening materials. Said hardening materials are have a melting point between 30° and 250° C, and more preferably between about 37° and about 80° C (see column 32, lines 8-12), this anticipates **instant claims 2 and 3**. Said hardening materials are selected from fatty acid esters such as mono-, di-, or triglycerides (see column 32, lines 21 and 49-50), animal based fats and oils and vegetable oils, such as hydrogenated castor oil or hydrogenated rapeseed oil (see column 32, lines 21, 58, and 67, and column 33, lines 3-4), fatty acids having from about 10 to 40 carbon atoms, such as triglycerides or diglycerides (see column 32, lines 22-23 and column 33, lines 47-48), fatty alcohols such as cetyl alcohol and behenyl alcohol (see column 32, lines 20, 34-48, and claim 10), and alpha-hydroxy fatty acids and fatty acids having from about 10 to about 40 carbon atoms, such as behenic, euric,

stearic, and lauric acids (see column 32, line 22 and column 33, lines 12-16), these anticipate **instant claims 4, 5, 6, 7, 9-11, 13-15** respectively. The hardening components are taught as being present in the McAtee in a range of about 0.1% to about 99.9%, and more preferably about 2% to about 25% of the conditioning component (see column 32, lines 1-7), this reads on **instant claims 12, 16**, and the broadest reasonable interpretation of indefinite **instant claim 8** (see 112 second paragraph rejection above). McAtee also teaches that the lipid phase can comprise 10% petrolatum, 5% tribehenin, 2% vitamin E acetate, 3% synthetic beeswax, 9% polyethylene wax, and 0% water, these anticipate **instant claims 17, 18, and 24**, components (a)-(f) respectively (see column 53, lines 33-42). Furthermore, component (a) can alternatively be a C8-C30 dialkyl ether (see column 25, line 47 through column 26, line 5, particularly noting petrolatum in line 58, and di C8-C30 alkyl ether in line 5), this anticipates **instant claim 19,** and the broadest reasonable interpretation of indefinite **instant claim 20** (see 112 second paragraph rejection above). In one of the preferred embodiments of McAtee, the lipid phase comprises at least two components that could be considered active agents, specifically, vitamin E acetate and tribehenin (see column 53, lines 36-38), this anticipates **instant claim 21**. Furthermore, vitamin E acetate, also known as tocopheryl acetate, is taught as a non-steroidal cosmetic soothing agent which is useful for treating inflammation of the skin (see column 44, lines 7-9 and 65), this anticipates **instant claims 22 and 23**. McAtee also teaches the addition of thickeners (see column 29, lines 44-55), this anticipates **instant claim 25**. McAtee also discloses that the active can be a sunscreen (see column 47, line 26

through 65), this anticipates **instant claim 26**. The product of McAtee is taught as being flat, thick, circle, square, rectangular or oval pads (see column 15, lines 47-60), this anticipates **instant claim 27**. McAtee further discloses that the lipid and aqueous phases can be added sequentially in any order (see column 50, lines 22-24), this anticipates **instant claims 29-30**. The aqueous and lipid phases are taught as being applied by spraying methods (see column 55, lines 24-26), this anticipates **instant claim 31**. Also, it is disclosed that when water is involved in the manufacturing process, that the composition is dried so that it is substantially free of water (see column 50, lines 65-67), this anticipates **instant claim 32**. The drying process is disclosed as occurring by means of a convection oven, radiant heat source, microwave oven, forced air oven, or heat rollers or cans (see column 51, lines 3-5), this anticipates **instant claim 33**. McAtee also discloses a method of cleansing and conditioning the skin or hair with the device of McAtee (see column 51, lines 14-17), this anticipates **instant claim 35**.

With regards to **instant claim 28**, McAtee teaches that the device disclosed can comprise more than two layers (see column 9, lines 26-28). Furthermore, it is well known in the art when marketing a single use hygiene device to package the device.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29

USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-31 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-31 of copending Application No. 10/521,070. Although the conflicting claims are not identical, they are not patentably distinct from each other, particularly since claims 1-31 anticipate instant claims 1-31.

Claim 1 and instant claim 1 have a slight variation in that instant claim 1 does not allow the product to be a porous or absorbent sheet. Both the claims and the instant claims teach that the product can be a puff, pad, sponge, cotton ball, swab, brush, glove, mitt, or bar. Besides the slight variation in claim 1 and instant claim 1, the claims are identical. Claims 1-31 anticipate instant claims 1-31 because the specified products taught by both claims are not porous or absorbent sheets, such as puffs, pads, sponges, cotton balls, swabs, brushes, mitts, or bars. Because both of the applications read on identical forms of product, the slight variation in instant claim 1 is insufficient to overcome a finding of anticipation. Both applications claim the same products. The instant claims recite the same components as '070, other than porous or absorbent sheets. Furthermore, the copending claims are silent regarding porosity and

absorbency, hence including porous and non-porous as well as absorbent and non-absorbent sheets. The instant claims are therefore anticipated by the above identified copending claims of '070.

Claims 1-8, 10-14, 16-17, 19-20, and 27 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-20, 22-24, and 26-27 of copending Application No. 10/520,970. Although the conflicting claims are not identical, they are not patentably distinct from each other, particularly since the claims anticipate the instant claims.

Claim 1 of '970 teaches a product comprising an applicator other than a porous or absorbent sheet, which is a puff, pad, sponge, cotton ball, swab, brush, glove, mitt or bar. Said applicator has a wax phase applied (this anticipates **instant claims 1, 20, and 27**). Claims 2-8 are identical to **instant claims 2-8**, except for being dependent from independent claims 1, and are directly anticipatory over each other. Furthermore, **instant claims 10-14, 16, 18, 21-23, 28, 29, 31, 35** anticipate claims 9-14, 16-19, 22-24, and 26 respectively. Claim 15 anticipates **instant claims 17 and 19**. Claim 20 anticipates **instant claims 25 and 26**. Claim 27 anticipates **instant claims 21 and 35**.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claims 1, 2, 4, and 20 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1, 2, 5-7, and 26 of copending Application No. 10/541,950. Although the conflicting claims are not identical, they are not patentably distinct from each other, particularly since the claims anticipate the instant claims.

Claims 1 and 26 anticipate **instant claim 1**. Claims 2 and 6 anticipate **instant claims 2 and 4,** respectively. Claims 5 and 7 anticipate **instant claim 20**. The claims of '950 that anticipate the instant claims are anticipatory because the claims of '950 teach all the limitations of the instant claims in addition to further limitations. These limitations, such as waxes, fall within the scope of the instant claims. Therefore, since '950 teach a species of the broader genus of the instant claims, the instant claims are anticipated.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Conclusion

No claims are allowed. All claims are rejected. Claims 5 and 14 are objected.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to TREVOR M. LOVE whose telephone number is (571)270-5259. The examiner can normally be reached on Monday-Thursday 7:30-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sharmila Landau can be reached on 571-272-0614. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

TL

/Lakshmi S Channavajjala/
Primary Examiner, Art Unit 1611